

REMARKS

A. Status of the Claims

Claims 1-63 were filed. An election of species requirement was issued, and Applicant elected to prosecute, in effect, claims 1-19 and 31-41. The Office withdrew the remaining claims from prosecution, and Applicant has now canceled them. Claims 1 and 31 have been amended to address the outstanding rejection of those claims, and for no other reason. Claim 37 has been amended to improve readability, and for no other reason. Claims 12-18 have been canceled to expedite prosecution. Applicant may prosecute these claims in the future, and their cancellation should not be viewed as a relinquishment of the canceled subject matter. Therefore, after entry of these amendments, claims 1-11 and 31-41 will be pending.

B. Claims 1-11 and 31-41 Are Patentable over Whitin

The Office rejects these claims (and claims 12-18, which were canceled for the reason explained above) as being anticipated by U.S. Patent No. 6,190,396 to Whitin *et al.* ("Whitin"). Applicant has amended claims 1 and 31 to distinguish Whitin, and for no other reason. Applicant respectfully traverses.

1. Claim 1 and Its Dependents

Claim 1 is directed to a medical device that includes a body, a lumen, and a first needle guide channel. As filed, the lumen and first needle guide channel are configured in operative relation with each such that a needle that is backloaded into the first needle guide channel will be advanced out of the first needle guide channel by pulling on a length of suture that is connected to the needle and threaded through the lumen. The Office asserts that the device in Whitin meets these limitations because shaft structure 20 of needle driving device 10 has multiple channels

80—as shown in Whitin FIG. 9—within which a needle could be theoretically backloaded and advanced as claimed. Action at pages 2-3.

Whitin's needle driving device is a part-intensive pistol grip structure. Needles can be driven from the channels 80 shown in some of the figures by pulling on trigger 46 (see FIG. 1), which turns pinion gear 44 that is coupled to plunger 40. The rotation of pinion gear 44 advances rack 43 of plunger 40. FIGS. 5 and 6 shows that as plunger 40 is advanced, push rods 72 will in turn advance needles 70 out of the channels 80 in shaft structure 20 and into suture organizer 30. The description corresponding to FIG. 9 goes into even more detail, and explains that the device includes a needle actuator (e.g., element 150) that has an elongate portion 152 or a plurality of push rods 156 that advance needles 70 out of channels 80. The needle actuator is clearly advanced using trigger 46.

If one were to disassemble Whitin's trigger driven device and separate the shaft structure 20 from the trigger mechanism and the rest of the device, it is theoretically possible to backload¹ a needle into one of the channels 80 of that shaft structure such that the needle will be advanced out of that channel by pulling on a length of suture that is connected to it and threaded through the other lumen. **However**, that shaft structure—divorced from the remainder of the trigger driven device—could not be used to advance a backloaded needle in the claimed manner **during a medical procedure on a patient**. Nothing in Whitin suggests the feasibility of that possibility.

¹ It is not entirely clear, but the needle depicted in "Attachment #1" and referenced in paragraph 9 of the Action does not appear to be "backloaded" as that term is properly construed. Applicant's specification defines "backloaded" as follows: "The term 'backloaded' means that the needle is positioned in the needle guide channel such that it will be advanced, sharp end first, out of the needle guide channel by the suture when an end of the suture is pulled." Page 13, lines 7-9. An example of a backloaded needle is shown in FIG. 5. Applicant points this out to ensure that the Office understands the meaning of the term. It appears that the needle shown in Attachment #1 would **not** be advanced out of the back end of the channel sharp end first.

Accordingly, Applicant has amended claim 1 to recite that the medical device is configured such that “when the medical device is used during a medical procedure on a patient,” a needle that is backloaded into the first needle guide channel will be advanced out of the first needle guide channel by pulling on a length of suture that is connected to the needle and threaded through the lumen. As a result of this amendment, medical devices that are not configured to allow a needle that is backloaded into the first needle guide channel to be advanced out of the first needle guide channel **during a medical procedure on a patient** by pulling on a length of suture that is connected to the needle and threaded through the lumen **do not satisfy** the limitations of claim 1 or any of its dependent claims. Whitin falls into this category of medical devices and, therefore, does not anticipate claim 1.

The case of *In re Venezia*, 530 F.2d 956 (CCPA 1976) (a copy of which is provided for the Examiner’s convenience) shows that Applicant’s approach to distinguishing Whitin is appropriate. In that case, the Board affirmed an examiner’s indefiniteness rejection of several claims that included the phrase “may be” on grounds that the claims were “directed to an assembly to take place in the future. No present positive structural relationships are recited.” *Id.* at 958. The Federal Circuit’s predecessor court reversed, and specifically addressed the fact that one of the claims included the criticized language “may be slideably positioned.” *Id.* at 958-59. The court explained that this and similar language “defines present structures or attributes of the part of the ‘kit’ identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired[.]” and found “nothing wrong” with the language. *Id.* (emphasis added). The same logic applies to how Applicant’s amendment should be interpreted.

The Office may look to MPEP § 2114 (2100-57) when evaluating amended claim 1. None of the cases cited in that section compels a result different from the one Applicant proposes. The Federal Circuit in *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (copy enclosed), for example, explained that a functional limitation could be met by a prior art structure that was inherently capable of performing that function.

That is not the case with Whitin. As the court in *Venezia* reasoned, the amendment to claim 1 limits the structure of the claimed medical device to those medical devices that are configured to allow for the claimed needle advancement when the medical device is used during a medical procedure on a patient. Whitin's shaft structure 20—divorced from the remainder of the trigger-driven device—is not inherently capable of such a use.

The case of *Ex parte Masham* is equally distinguishable. 2 U.S.P.Q.2d 1647 (BPAI 1987) (copy enclosed). In *Masham*, the Board considered an anticipation rejection of a claim directed to an apparatus for mixing flowing developer material. *Id.* at 1648. A limitation in issue recited a means for mixing the flowing developer material, "said mixing means being stationary and **completely submerged** in the developer material." *Id.* The Board decided that although the cited anticipation reference disclosed the claimed mixing means in a position that was only **partially** submerged, it nevertheless met the limitation because that reference possessed the capability **to be operated** while the mixing means was totally submerged:

Williams' mixing device 40 is capable of being totally submerged in the developer material, since gate member 46 is capable of retaining a supply of developer above the top surface of mixing device 40.

Id. The Board emphasized that using the Williams device in the claimed fashion would not cause it to "undergo a metamorphosis to a new apparatus[.]" *Id.*

Whitin is different than the reference in *Masham* because the trigger device of Whitin is not capable of being used on a patient in the manner claimed. For such a capability to be

realized, Whitin's part-intensive trigger device would have to "undergo a metamorphosis to a new apparatus." That metamorphosis would necessarily involve taking the device apart and isolating a small portion of it (shaft structure 20). Moreover, there is no indication that—even if such a metamorphosis took place—shaft structure 20 could be used by itself and as claimed with any expectation of success.

2. Claim 31 and Its Dependents

Claim 31 has been amended in the same fashion as claim 1. Claim 31 and its dependents are therefore patentable for the same reasons as claim 1.

C. Conclusion

Applicant respectfully submits that claims 1-11 and 31-41 are in condition for allowance. Should the Examiner have any questions, comments, or suggestions relating to this application, he is invited to contact the undersigned attorney at (512) 536-3031.

Respectfully submitted,



Mark T. Garrett
Reg. No. 44,699
Attorney for Applicant

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 536-3031
Date: March 30, 2004

LEXSEE 530 F2D 956

IN THE MATTER OF THE APPLICATION OF J. WILLIAM VENEZIA

Patent Appeal No. 75-601

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

530 F.2d 956; 1976 CCPA LEXIS 186; 189 U.S.P.Q. (BNA) 149

March 11, 1976, DECIDED.

PRIOR HISTORY: [**1] Serial No. 31,500.

LexisNexis (TM) HEADNOTES - Core Concepts:

OPINIONBY:

LANE

OPINION: [*956]

LANE, Judge.

This is an appeal from the decision of the Patent and Trademark Office Board [*957] of Appeals (board) affirming the rejections of claims 31 through 36 in application serial No. 31,500, filed April 24, 1970, for "Method of Splicing High Voltage Shielded Cables and Splice Connector Therefor." We reverse.

The Invention

Appellant's invention is a splice connector having interrelated parts adapted to be assembled in the field to provide a splice connection between a pair of high voltage shielded electric cables.

Appellant's application contains claims drawn to the completed connector and to the method of making the splice connection, which have been allowed by the Patent and Trademark Office. On appeal before us are claims drawn to a splice connector "kit" consisting of the parts which are used in making the splice in their unassembled condition.

Claim 31, with our emphasis, is representative of the claims on appeal:

31. A splice connector kit having component parts capable of being assembled in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between [**2] first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means adapted to be affixed to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members adapted to be positioned respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position

relative [**3] to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable whereby said housing may be slideably positioned over one of said cables and then slideably repositioned over said sleeves, said retaining members, and said contact means when said sleeves, said retaining members and said contact means are assembled on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors when said housing is in its repositioned location.

The Rejections

Claims 31-36 were rejected under 35 USC 112, second paragraph, as indefinite and incomplete in not defining [**4] a complete article of manufacture. The examiner particularly relied on *In re Collier*, 55 CCPA 1280, 397 F.2d 1003, 158 USPQ 266 (1968), as support for this rejection.

Claims 31-36 were additionally rejected under 35 USC 101 because they were drawn to a plurality of separately and discretely listed and defined manufactures instead of a manufacture. [*958]

The Board

The board at first unanimously sustained both of the above rejections. With respect to the section 112 rejection it stated:

In the *Collier* case, the two elements [see bracketed elements [1] and [2] of *Collier* claim 17, *infra*] recited specifically in the claims there under consideration were described in terms of intended uses and capability, and the like. The Court said:

"We agree with the Board, however, that the claim does not positively recite structural relationships of the two elements, identified as (1) and (2) above, in its recitation of what may or may not occur. In this sense it fails to comply with section 112, [second paragraph] In [sic] failing distinctly to claim what appellant in his brief insists is his actual invention."

An inspection of the claims here under consideration, [**5] see for example claim 31 above, discloses a similar situation. Although the preamble

refers to the structure as a "kit", the elements are recited without present cooperation. The language is futuristic and conditional in character, thus, a pair of sleeves - to be fitted - electrical contact means - to be affixed - a pair of retaining numbers [sic, members] - to be positioned - a housing - may be slideably positioned - slideably repositioned - when said sleeves are assembled on said cables - when said housing is in its repositioned location.

From the above it is clear that the language of the claim taken as an example is directed to assembly to take place in the future. No present positive structural relationships are recited.

In affirming the section 101 rejection the board stated:

[Appellant] urges that the elements of his claimed combination are "joined together in a kit of component parts". Such joining as may be recited in the claims, as we have pointed out above in connection with the rejection under 35 USC 112, relates to matters which may take place in the future. No present coaction is recited. The presence of the word "kit" in the preamble, we do not think [**6] fairly links the elements separately recited in the claims. Appellant has referred to no language in the claims which would support such "joining" and we know of none. [Emphasis in original.]

In a subsequent decision, upon reconsideration, one of the board members dissented, finding that appellant had distinctly claimed what he regarded as his invention under section 112. The dissenting member of the board also found that it was not fatal under section 101 that the cooperation of the claimed elements was recited as occurring at a future time.

This posture of the board remained intact following a third opinion rendered after a second request for reconsideration by appellant.

OPINION

Section 112 Rejection

We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as required by the second paragraph of section 112. *In re Conley*, 490 F.2d 972, 180 USPQ 454 (CCPA 1974); *In re Miller*, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971); *In re Borkowski*, [**7] 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970). As we view these claims, they precisely define a group or "kit" of interrelated parts. These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is not a

part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts [*959] are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves ... each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of [*8] the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves ... are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. *In re Miller, supra*.

We also fail to see any basis [*9] for rejecting appellant's claims for being incomplete in failing to recite a completed assembly. Appellant's invention is a "kit" of parts which may or may not be made into a completed assembly. Since all of the essential parts of the "kit" are recited in the claims, there is no basis for holding the claims incomplete.

We cannot leave our discussion of the section 112 rejection without discussing *In re Collier, supra*, relied on by both the examiner and the board as support for this rejection. In *Collier* we were confronted by the following claim:

17. For use in a ground connection,

[1] a connector member for engaging shield means of a coaxial cable means,

said connector member comprising a substantially rectangular piece of metal formed into trough form to define a ferrule-forming member, said ferrule-forming member having

a series of perforations disposed therein toward the axis of the ferrule-forming member and defining inwardly directed frusto-conical projections having jagged edges defining lances converging toward their tips,

said ferrule-forming member being crimpable onto said shield means with said lances keying into said shield means without penetrating insulation [*10] means disposed thereunder,

[2] and ground wire means for disposition between said ferrule-forming member and said shield means upon the ferrule-forming member being crimped onto the shield means,

said ground wire means being displaced in a series of bights around respective perforations to effect serpentine form when said ferrule-forming member is crimped onto said shield means. [55 CCPA at 1281-82, 397 F.2d at 1004-05, 158 USPQ at 267. (Emphasis and brackets in original opinion).]

In *Collier* appellant argued that we were to regard the italicized portions of claim 17 about intended uses, capabilities, and structures which would result upon the performance of future acts, as positive structural limitations. However, we found that the claim did not positively recite any structural relationship between the two elements identified as [1] and [2], in its recitation of what may or may not occur. We concluded that the [*960] claim failed to comply with section 112, second paragraph, in "failing distinctly to claim what appellant in his brief insists is his actual invention."

There is no issue in this case of whether appellant is claiming what he regards as his invention. [*11] Moreover, although the claims before us contain some language which can be labeled "conditional," this language, rather than describing activities which may or may not occur, serves to precisely define present structural attributes of interrelated component parts of the "kit," such that a later assembly of the "kit" of parts may be effected. Thus, we find *In re Collier* inapposite to the claims presently before us.

Section 101 Rejection

35 USC 101 provides in pertinent part:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter ... may obtain a patent therefor ...

Both the examiner and the board construed the language "any ... manufacture" as excluding from its ambit claims drawn to a "kit" of parts, reasoning that a "kit" would be a plurality of separate manufactures, not a single manufacture.

The solicitor in his brief recognizes that the Patent and Trademark Office has in the past issued patents containing similar claims drawn to "kits" of interrelated parts. n1 He argues, however, that double patenting decisions by this court, holding that an inventor may obtain only one patent on a single invention, show that this [**12] court has interpreted portions of section 101 in the singular. From this he reasons that the word "manufacture" in section 101 is to be similarly interpreted.

n1 There are copies of several patents in the record which contain "kit" claims exemplifying this prior practice, including patent No. 3,108,803, claiming a basketball goal set kit, patent No. 3,041,778, claiming a puppet kit, patent No. 1,974,838, claiming a toy construction set, and patent No. 3,355,837, also claiming a toy construction set.

We do not find our decisions on double patenting to be applicable to an interpretation of the words "any

manufacture" in section 101. Suffice it to say that the two situations are totally dissimilar. In the section 101 "same invention" type double patenting cases, all we were construing was the phrase "a patent therefor."

No other authority has been cited, either by the board or the solicitor, to support the narrow construction which the Patent and Trademark Office now seeks to impose on the words "any manufacture" in section 101.

We do not believe the words in question are to be so narrowly construed. To hold that the words "any manufacture" exclude from their meaning groups [**13] or "kits" of interrelated parts would have the practical effect of not only excluding from patent protection those "kit" inventions which are capable of being claimed as a final assembly (e.g., a splice connector), but also many inventions such as building blocks, construction sets, games, etc., which are incapable of being claimed as a final assembly. We do not believe Congress intended to exclude any invention from patent protection merely because it is a group or "kit" of interrelated parts. We therefore hold that a group or "kit" of interrelated parts is a "manufacture" as that term is used in section 101.

Accordingly, the decision of the board is reversed.

REVERSED

LEXSEE 128 F3D 1473

IN RE SCHREIBER

97-1201

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

128 F.3d 1473; 1997 U.S. App. LEXIS 29099; 44 U.S.P.Q.2D (BNA) 1429

October 23, 1997, Decided

SUBSEQUENT HISTORY: **[**1]** Suggestion for Rehearing In Banc Declined and Rehearing Denied December 17, 1997, Reported at: *1997 U.S. App. LEXIS 37546*.

PRIOR HISTORY: Appealed from: Patent and Trademark Office Board of Patent Appeals and Interferences. (Serial No. 08/187,111).

DISPOSITION: AFFIRMED.

LexisNexis (TM) HEADNOTES - Core Concepts:

COUNSEL: Joseph B. Taphorn, of Poughkeepsie, New York, argued for appellant.

Joseph G. Piccolo, Associate Solicitor, Office of the Solicitor, Patent and Trademark Office, Department of Commerce, of Arlington, Virginia, argued for the appellee. With him on the brief were Nancy J. Linck, Solicitor, Albin F. Drost, Deputy Solicitor, and Karen A. Buchanan, Associate Solicitor.

JUDGES: Before NEWMAN, PLAGER, and BRYSON, Circuit Judges. Opinion for the court filed by Circuit Judge BRYSON. Dissenting opinion filed by Circuit Judge NEWMAN.

OPINIONBY: BRYSON

OPINION: **[*1474]** BRYSON, Circuit Judge.

Stephen B. Schreiber appeals the decision of the United States Patent and Trademark Office's Board of Patent Appeals and Interferences sustaining a final rejection of four claims of Schreiber's patent application. We affirm.

I

Schreiber's patent application claims a device for dispensing popped popcorn. The device is conically shaped with a large opening that fits on a container and a smaller opening at the opposite end that allows popped popcorn to pass through when the device is attached **[**2]** to a popcorn container and turned upside down. An embodiment disclosed in Schreiber's patent application is depicted below. **[*1475]**

[SEE ILLUSTRATION IN ORIGINAL].

Schreiber filed a number of claims, and the examiner allowed many of the claims. Claims 1, 2, 14, and 15 were finally rejected, however, and those claims are the subjects of this appeal. Claim 1 recites:

A dispensing top for passing only several kernels of a popped popcorn at a time from an open-ended container filled with popped popcorn, having a generally conical shape and an opening at each end, the opening at the reduced end allows several kernels of popped popcorn to pass through at the same time, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container.

Claim 2 is similar to claim 1 but additionally recites that the top comprises a "means at the reduced end of the top to close-off the opening thereat." The other two claims, claims 14 and 15, depend from claims **[**3]** 1 and 2,

respectively. Schreiber does not argue that claims 14 and 15 are patentable if claims 1 and 2 are not. Accordingly, because we affirm the rejection of claims 1 and 2, we need not address claims 14 and 15.

Claim 1 was rejected by the examiner under 35 U.S.C. § 102(b) as being anticipated by Swiss Patent No. 172,689 to Harz. The Harz patent discloses "a spout for nozzle-ready canisters," which may be tapered inward in a conical fashion, and it states that the spout is useful for purposes such as dispensing oil from an oil can. The examiner explained that Harz discloses a conical dispensing top for an open-ended container and concluded that "the Harz top is clearly capable of dispensing popped popcorn." Figure 5 from Harz is depicted below. [*1476]

[SEE ILLUSTRATION IN ORIGINAL].

Claim 2 was rejected by the examiner under 35 U.S.C. § 103 as being unpatentable over the combination of Harz and U.S. Patent No. 3,537,623 to Fisher. The examiner stated that although Harz does not disclose a "means at the reduced end of the top to close-off the opening thereat," Fisher does. The examiner concluded that it would have been obvious to one of ordinary skill in the art to modify [*4] Harz in view of Fisher in order to "seal[] the container contents from contaminates."

In response to the patent examiner's rejections, Schreiber submitted a declaration stating that the conical dispensing top depicted in figure 5 of Harz was incapable of "jamming up the popped popcorn before the end of the cone and permitting the dispensing of only a few kernels at a shake of a package when the top is mounted on the container." The examiner did not enter that declaration in the record because he believed it had not been properly submitted. When Schreiber appealed to the Board, the Board remanded the case to the examiner to consider the declaration. On remand, the examiner considered the declaration but found that it did not provide sufficient information to support Schreiber's assertion that a dispensing top built according to Harz does not inherently possess the functionally defined limitations recited in the claims.

Schreiber again appealed to the Board, which upheld the rejections. The Board first found that Harz discloses every limitation recited in claim 1. Several of the recitations in the claims, the Board concluded, merely set forth the function and intended use [*5] of the top and therefore did not require any structural feature other than those taught by Harz. The Board found that the structure disclosed by Harz is inherently capable of dispensing popcorn in the manner set forth in the claims, and that Schreiber's declaration did not provide enough details to

prove that the structure disclosed by Harz is incapable of performing the claimed functions of Schreiber's invention.

In response to Schreiber's argument that the conical dispensing top disclosed in Harz is designed to dispense liquids such as oil, rather than solid items such as popcorn, and that it is not large enough to pass popcorn kernels, the Board noted that the Harz patent referred to the use of the claimed device for lubricating oil only as an "example," and found that one of skill in the art "would perceive the top of Harz as being of broader application." The Board further found that the dispensing top disclosed in Harz "is of a relative size and has a taper which would inherently permit popped popcorn kernels to jam up before the end of the cone and permit the dispensing of only a few kernels at a [*1477] shake of the package" when the top is mounted on a popped popcorn container. [*6] Accordingly, the Board concluded that "all the limitations of claim 1 are found in Harz, either expressly or under the principles of inherency, and this claim is clearly anticipated thereby."

As for claim 2, the Board found that Fisher disclosed a means for closing off the smaller end of a conically shaped top and further found that it would have been obvious to one of ordinary skill in the art to provide a close-off mechanism for a top of the sort disclosed by Harz, to prevent dirt and other contaminating matter from entering the opening in the device. Schreiber appeals both of the Board's determinations.

II

Schreiber first argues that Harz does not anticipate claim 1. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2D (BNA) 1565, 1567 (Fed. Cir. 1995). Anticipation is an issue of fact, see *In re Graves*, 69 F.3d 1147, 1151, 36 U.S.P.Q.2D (BNA) 1697, 1700 (Fed. Cir. 1995); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2D (BNA) 1315, 1317 (Fed. Cir. 1988), and the question whether a claim limitation is inherent in a [*7] prior art reference is a factual issue on which evidence may be introduced, see *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991).

There is no dispute that the structural limitations recited in Schreiber's application are all found in the Harz reference upon which the examiner and the Board relied. Thus, to use the terms found in Schreiber's claim 1, Harz discloses a "dispensing top" that has "a generally conical shape and an opening at each end," and "means at the

enlarged end of the top to embrace the open end of the container, the taper of the top being uniform." Schreiber argues, however, that Harz does not disclose that such a structure can be used to dispense popcorn from an open-ended popcorn container.

Although Schreiber is correct that Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. See *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. [*8] Cir. 1990) ("The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 782, 227 U.S.P.Q. (BNA) 773, 778 (Fed. Cir. 1985) (composition claim reciting a newly discovered property of an old alloy did not satisfy section 102 because the alloy itself was not new); *In re Pearson*, 494 F.2d 1399, 1403, 181 U.S.P.Q. (BNA) 641, 644 (CCPA 1974) (intended use of an old composition does not render composition claim patentable); *In re Zierden*, 56 C.C.P.A. 1223, 411 F.2d 1325, 1328, 162 U.S.P.Q. (BNA) 102, 104 (CCPA 1969) ("Mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable."); *In re Sinex*, 50 C.C.P.A. 1004, 309 F.2d 488, 492, 135 U.S.P.Q. (BNA) 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); *In re Hack*, 44 C.C.P.A. 954, 245 F.2d 246, 248, 114 U.S.P.Q. (BNA) 161, 162 (CCPA 1957) ("the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition"); *In re Benner*, 36 C.C.P.A. 1081, 174 F.2d 938, 942, 82 [*9] U.S.P.Q. 49, 53 (CCPA 1949) ("no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product"). Accordingly, Schreiber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn.

Schreiber makes the closely related argument that Harz does not anticipate claim 1 because Harz is non-analogous art to which one of ordinary skill in the art would not have looked in addressing the problem of dispensing tops for popped popcorn containers. [*1478] However, the question whether a reference is analogous art is irrelevant to whether that reference anticipates. See *In re Self*, 671 F.2d 1344, 1350, 213 U.S.P.Q. (BNA) 1, 7 (CCPA 1982). A reference may be from an entirely

different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims.

Schreiber further argues that the functional limitations of his [*10] claim distinguish it from Harz. In particular, Schreiber points to the recitation that the claimed top "allows several kernels of popped popcorn to pass through at the same time," and that the taper of the top is such "as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container."

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 U.S.P.Q. (BNA) 226, 228 (CCPA 1971) ("There is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 U.S.P.Q. (BNA) at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter [*11] shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 U.S.P.Q. (BNA) 609, 611 (CCPA 1981); *In re Ludtke*, 58 C.C.P.A. 1159, 441 F.2d 660, 663-64, 169 U.S.P.Q. (BNA) 563, 565-67 (CCPA 1971).

The examiner and the Board both addressed the question whether the functional limitations of Schreiber's claim gave it patentable weight and concluded that they did not, because those limitations were found to be inherent in the Harz prior art reference. To begin with, contrary to the characterization in the dissent, nothing in Schreiber's claim suggests that Schreiber's container is "of a different shape" than Harz's. In fact, as shown above, an embodiment according to Harz (Fig. 5) and the embodiment depicted in figure 1 of Schreiber's application have the same general shape. For that reason, the examiner was justified in concluding that the opening of a conically shaped top as disclosed by Harz is

inherently of a size sufficient to "allow[] several kernels of popped popcorn to pass through at the same time" and that the taper of Harz's conically shaped top is inherently of such a shape "as to by itself jam up the popped popcorn before the end [**12] of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container." The examiner therefore correctly found that Harz established a prima facie case of anticipation.

At that point, the burden shifted to Schreiber to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. See *In re Spada*, 911 F.2d at 708, 15 U.S.P.Q.2D (BNA) at 1658; *In re King*, 801 F.2d 1324, 1327, 231 U.S.P.Q. (BNA) 136, 138-39 (Fed. Cir. 1986); *In re Best*, 562 F.2d 1252, 1254-55, 195 U.S.P.Q. (BNA) 430, 433 (CCPA 1976). The Board found that Schreiber failed to do so, and we agree. Schreiber's declaration asserts that he built a conically shaped top according to figure 5 of Harz and that it was too small to jam and dispense popcorn as recited in the claim. The declaration, however, does not specify the dimensions of either the dispensing top that was tested or the popcorn that was used.

Moreover, the Board found as a factual matter that the top disclosed in figure 5 of the Harz patent "is capable of functioning to dispense kernels of popped popcorn in the manner set forth in claim 1." Starting with Schreiber's [**13] assumption that Harz should be limited to use as an attachment to an oil can, the Board scaled figure 5 to the proportions necessary to fit the Harz container on top of a standard one-quart oil can, as Schreiber suggested in his request for reconsideration. After scaling the Harz figure in that manner, the Board found that the Harz dispenser [*1479] would be capable of dispensing popcorn in the manner set forth in claim 1 of Schreiber's application.

The dissenting opinion incorrectly states that the Board "used Mr. Schreiber's invention as a template" in determining that the Harz dispenser anticipates Schreiber's invention. In fact, the Board simply scaled the dispenser illustrated in Harz figure 5 up to the size necessary to fit a standard oil can, without changing the proportions of the figure in any way. (The top depicted in figure 5 of the Harz patent was obviously not intended to be a full-sized representation of the Harz invention, any more than the top depicted in figure 1 of Schreiber's application was intended to be a full-sized representation of his invention.) The portion of the dissenting opinion addressed to this point is therefore based on a false premise - that the prior [**14] art device was "altered by the Board and then found to anticipate a different invention in whose image it was recreated." The Board's

finding that the scaled-up version of figure 5 of Harz would be capable of performing all of the functions recited in Schreiber's claim 1 is a factual finding, which has not been shown to be clearly erroneous. On this ground alone, the Board's anticipation ruling must be upheld.

In any event, however, it is not enough for Schreiber to contend that a top built according to the proportions of figure 5 of Harz is incapable of performing the jamming and dispensing functions. The figures from Harz were provided only as "design examples of the invention"; the disclosure of the Harz patent is thus much broader than the precise conical shape disclosed in figure 5. Moreover, contrary to Schreiber's suggestion, the structure disclosed in Harz is not limited to use as an oil can dispenser. While that use is given as the principal example of the uses to which the invention could be put, nothing in the Harz patent suggests that the invention is in any way limited to that use. In sum, Schreiber's declaration fails to show that Harz inherently lacks the functionally [**15] defined limitations recited in claim 1 of the application. Accordingly, we agree with the Board that Schreiber has failed to rebut the prima facie case of anticipation identified by the examiner. The Board's factual finding on the issue of anticipation is therefore affirmed.

III

Schreiber also challenges the Board's finding that claims 2 and 15 are unpatentable under 35 U.S.C. § 103 as being obvious over the combination of Harz and Fisher. Schreiber argues that the combination of Harz and Fisher does not disclose all the limitations of claim 2 because neither Harz nor Fisher discloses the functionally defined features of the top. That argument is without merit because, as we have already noted, Harz discloses those functionally defined limitations.

Schreiber also argues that Fisher does not provide the function that the "means for closing off" in Schreiber's application provides. The functions Schreiber cites - enabling a person to carry a popped-popcorn package in a non-upright position without spillage, keeping the popcorn warm, and facilitating the mixing of ingredients - are not recited as part of the means-plus-function clause in claim 2. Accordingly, those functions cannot [**16] impart patentability to the claim.

Schreiber further argues that Fisher is non-analogous art because Fisher relates to pouring oil from an oil can whereas Schreiber's invention relates to popcorn dispensing. That argument was not raised before the Board and we therefore decline to consider it for the first time on appeal. Even if we were to consider that argument, however, we note that Schreiber

acknowledges in the specification that the prior art pertinent to his invention includes patents relating to dispensing fluids. Schreiber therefore may not now argue that such patents are non-analogous art. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570, 7 U.S.P.Q.2D (BNA) 1057, 1063 (Fed. Cir. 1988); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 535 (CCPA 1980); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. (BNA) 171, 174 (CCPA 1979); *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 611-12 (CCPA 1975). Accordingly, we find no error in the Board's [*1480] determination that claims 2 and 15 would have been obvious.

AFFIRMED.

DISSENTBY: NEWMAN

DISSENT: NEWMAN, Circuit Judge, dissenting.

I respectfully dissent. The panel majority affirms the PTO position that the express limitations [**17] of the claims are irrelevant when dealing with a rejection on the ground of "anticipation." The court thus departs from the rules of claim interpretation on which we have placed so much weight. The Federal Circuit has held, over and over, that every claim limitation is important and none can be ignored -- and now proceeds to ignore several express limitations. Thus the panel incongruously holds that a claim that requires, explicitly and precisely, a container of popcorn and a dispenser that passes only a few kernels of popcorn before jamming, is "anticipated" by an oil can of a different shape as illustrated in a reference that neither shows nor suggests a container filled with popcorn or the jamming of the dispenser upon dispensing the popcorn. I feel for those who tread the arcane path of patent soliciting, for this court's insistence on the importance of the limitations in the claims seems to have lost its way.

Schreiber's claims 1 and 14 are representative:

1. A dispensing top for passing only several kernels of a popped popcorn at a time from an open-ended container filled with popped popcorn, having a generally conical shape and an opening at each end, the opening at the [**18] reduced end allows several kernels of popped popcorn to pass through at the same time, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a

shake of a package when the top is mounted on the container.

14. A package consisting of a container having popped popcorn and having an open end and embracing thereat a dispensing top according to claim 1.

The Board held that it is irrelevant that the Schreiber claims are limited to a container filled with popped popcorn with the additional limitation of dispensing a few kernels at a time before the dispenser jams up. No popcorn container or dispenser was cited by the PTO, and no similar claim limitations were cited by the PTO. These claim limitations can not be ignored. See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 U.S.P.Q.2D (BNA) 1321, 1324 (Fed. Cir. 1987) (the court can not ignore a plethora of meaningful limitations). Patentability is determined for the invention as claimed, with all its limitations. It is improper to [**19] delete explicit limitations from the claim in order to find the residue in the prior art.

"That which infringes if later anticipates if earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 U.S.P.Q. (BNA) 561, 574 (Fed. Cir. 1986) (citing *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537, 32 L. Ed. 738, 9 S. Ct. 389 (1889)). It is inconceivable that this or any court would find Mr. Schreiber's claims to this popcorn dispenser infringed by the oil can of the Harz reference. The claim limitations that the container is filled with popped popcorn and that only a few kernels of popcorn are released at a time could not be ignored in an infringement action, and they are not properly ignored in a patentability action.

The Board, using Mr. Schreiber's invention as a template, rescaled the prior art and filled the oil can with popcorn. This exercise of hindsight is not "anticipation." The law of anticipation requires that the same invention, with all the limitations of the claims, existed in the prior art. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920-21 (Fed. Cir. 1989) ("anticipation" requires that the identical invention is described in a single prior art reference). A [**20] prior art device can not be altered by the Board and then found to anticipate a different invention in whose image it was recreated.

In responding to the PTO's rejection, Mr. Schreiber made an actual conical top according to the Harz oil can's proportions, and reported that the popcorn did not behave as in his device. The Board then proposed that [**1481] Mr. Schreiber had erred in determining the diameter of the opening, and postulated that with the appropriate opening the Harz oil can might behave as does Mr. Schreiber's container. Mr. Schreiber says this is incorrect. I say it is irrelevant. See, e.g., *Richardson*, 868

F.2d at 1236, 9 U.S.P.Q.2D (BNA) at 1920 (every element of the claim must be shown in the reference, including all limitations); *In re Paulsen, 30 F.3d 1475* (the reference must describe the claimed invention sufficiently to place it in the possession of a person of ordinary skill in the field).

Mr. Schreiber's popcorn dispenser is not described in the prior art. Statements in the claims that define and limit the device are material limitations, for purposes of infringement and for purposes of distinguishing from the prior art. See, e.g., *Rowe v. Dror, 112 [**21] F.3d 473, 478-79, 42 U.S.P.Q.2D (BNA) 1550, 1553-54 (Fed. Cir. 1997)* (the field of the invention as stated in a Jepson-type claim limits the invention); *Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-78, 7 U.S.P.Q.2D (BNA) 1315, 1317 (Fed. Cir. 1988)* (limitations stated in the preamble limit the claimed invention); *In re Stencel, 828 F.2d 751, 754-55, 4 U.S.P.Q.2D (BNA) 1071, 1073 (Fed. Cir. 1987)* (function stated in claim distinguishes from prior art). The rejection for lack of novelty is simply incorrect.

In *Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997)* the Court stressed the importance of claim limitations. The cases cited by the panel majority relate to the discovery of a new use of a known composition or device, and hold that the discovery of that use does not render patentable that which is already known. However, Schreiber's device is not known, but is new, and the claims are explicitly so limited. See *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1255-57, 9 U.S.P.Q.2D (BNA) 1962, 1965-66 (Fed. Cir. 1989)* ("To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality."); [**22] *W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 or 842 F.2d 1275* (anticipation can not be based on conjecture). The claimed popcorn dispenser having a novel structure and function, whereby the container is filled with popcorn and after a few kernels of popcorn are released the dispenser jams up, is not in the cited prior art. The explicit claim limitations must be considered in determination of anticipation, just as they would be considered in construing the claims for

the purpose of determining infringement. They can not be ignored.

Since no prior art shows this device, it can not be "anticipated" as lacking novelty.

B

The panel majority suggests that it would be "inherent" to use the oil can as a popcorn dispenser. An inherent disclosure, to be invalidating as an "anticipation," is a disclosure that is necessarily contained in the prior art, and would be so recognized by a person of ordinary skill in that art. *Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 U.S.P.Q.2D (BNA) 1746, 1749-50 (Fed. Cir. 1991)*. "Inherency" charges the inventor with knowledge that would be known to the art, although not described. Inherency is not a matter of hindsight [**23] based on the applicant's disclosure: the missing claim elements must necessarily be present in the prior art.

The authority cited by the majority, relating to claiming a known composition or device based on discovery of a new use, is inapt. It is of course correct that the discovery of a new use of a known composition or device does not render that composition or device patentable per se. The reason, however, is not "inherency"; it is that the composition or device is already known to the public, and can not be removed from the public. (The new use can of course be claimed as a method of use.) In this case, however, Mr. Schreiber has created a new device, not previously known to the public, and has claimed his new device with explicit limitations that distinguish it from previously known devices.

In passing, I also observe that the majority errs in stating that advantages not recited in the claim can not impart patentability to a new device. The advantages of an invention are often relied on to support patentability; whether they are included in the claim depends on a variety of factors, and is not the subject of a rigid rule.

[*1482] The issue in this case is anticipation; that is, novelty. [**24] Since the claimed invention is not described in a single prior art reference, it is not "anticipated."

LEXSEE 2 USPQ2D 1647

Ex parte Roger D. Masham

Appeal No. 671-94 from Art Unit 152.

Application for Patent filed May 24, 1984, Serial No. 613,686. Mixing Device For
Particulate Material.

Board of Patent Appeals and Interferences

1987 Pat. App. LEXIS 23; 2 U.S.P.Q.2D (BNA) 1647

February 26, 1987, Decided

[*1]

Before Serota, Chairman, and Pellman, Seidleck, Lovell and Steiner, Examiners-in-Chief.

COUNSEL:

Henry Fleischer et al. for appellants.
Henry Fleischer et al.
Xerox Corporation
Xerox Square 020
Rochester, NY 14644

Primary Examiner - Norman Morgenstern.

Examiner - Kenneth Jaconetty.

OPINIONBY: STEINER

OPINION:

Steiner, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1 through 9. In an amendment submitted on June 24, 1985, claims 2 through 9 were cancelled leaving claim 1. There are no other claims remaining in the application.

Claim 1 reads as follows:

1. An apparatus for mixing flowing developer material, including:
means, defining a chamber, for receiving the flowing developer material therein; and
means for mixing the flowing developer material, said mixing means being stationary and completely submerged in the developer material.

The reference relied upon by the examiner is:
Williams 4,075,977 Feb. 28, 1978

The appealed claims stand rejected under 35 U.S.C. 102(b) as anticipated by Williams. We affirm.

Structurally, the claimed apparatus comprises a chamber and stationary mixing means situated therein. The preambular recitation "for mixing flowing developer [*2] material . . ." and the additional recitation "completely submerged in the developer material" relate to the identity of the material worked upon by the claimed apparatus and the intended manner of employing the claimed apparatus.

Williams discloses an apparatus satisfying the structural requirements of that claimed; i.e., the disclosed apparatus comprises a chamber and a stationary mixing means situated therein. The disclosed apparatus also enjoys the same utility as that claimed; i.e., for mixing flowing developer material. As the only difference between the claimed invention and the apparatus disclosed by Williams, appellant argues that the mixing means of the claimed apparatus is "completely submerged in the developer material"; whereas, in Williams' apparatus, the mixing means is depicted "as only being partially submerged in the developer material" (page 4 of the brief, first full paragraph).

The apparatus disclosed by Williams is employed to mix developer material. Accordingly, the disclosed apparatus satisfies the recitations in claim 1 with respect to the identity of the material intended to be worked upon by the claimed apparatus and the general manner in [*3] which the claimed apparatus is intended to be employed. At any rate, a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Rishoi*, 197 F.2d 342, 94 USPQ 71 (CCPA 1952) and *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973), *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). In this respect, the examiner has factually determined that Williams' mixing device 40 is capable of being totally submerged in the developer material, since gate member 46 is capable of retaining a supply of developer above the top surface of mixing [*4] device 40. Appellant has not challenged the examiner's factual determination, which determination appears to be based upon sound technical reasoning.

In *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), it was held that a recitation of intended use in a claim directed to a composition does not impose any limitations which differentiates the claimed composition from those which are known in the art. By analogy, the apparatus disclosed by Williams does not undergo a metamorphosis to a new apparatus merely by affixing instructions thereto indicating that a sufficient amount of developer material may be poured into the apparatus to completely submerge the stationary mixing means.

Based upon the foregoing, we agree with the examiner's position that the recitation "completely submerged in the developer material" does not impose any structural limitations upon the claimed apparatus which differentiates it from that disclosed by Williams. We, therefore, agree with the examiner's determination that Williams' apparatus anticipates that claimed within the meaning of 35 U.S.C. 102(b).

AFFIRMED